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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,158	05/29/2001	Akira Wakabayashi	892_017	5962
25191	7590	04/19/2005	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/867,158

Applicant(s)

WAKABAYASHI ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/10/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment received on 12/15/2004 is acknowledged and entered. The applicant has amended claims 1-6 and 9. Currently, claims 1-9 are pending for examination.

### ***Response to Arguments***

- 2.1. Applicant's arguments, see page 9 of the Remarks, filed 12/15/2004, with respect to rejection of claims 1-9 under 35 USC 101 have been fully considered and are persuasive in view of the amendments made to claims 1-6 and 9 and accordingly, this rejection has been withdrawn.
- 2.2. Applicant's arguments, see page 9 of the Remarks, filed 12/15/2004, with respect to rejection of claims 1-6 under 35 USC 102 (e) as being anticipated by Freeland and rejection of claims 6-9 under 103 (a)1 as being unpatentable over Freeland in view of Merrick have been fully considered and are persuasive in view of the submission of verified translations of JP'275 and JP'157 made to claims 1-6 and 9 and accordingly, this rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

- 3.1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Green et al. (US Patent 6,041,310), hereinafter, referred to Green.

3.2. *Note : Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.*

3.3. *Please note that the claims 1-2, and 6-8 are system claims and are considered as apparatus and article claims. As per MPEP 2114 [R-1], " APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)."*

Regarding claim 1, Green teaches a car sale information providing system (see at least col.3, lines 36-57, " .....**The present invention also comprehends a method for facilitating an**

*automobile purchase transaction between a customer and an automobile dealership. .... The method further includes providing a customer transaction terminal including a display/input terminal and a terminal processor and providing a storage device containing customer data, vehicle data, vehicle images, instructional audio, video, and a payment module. A multilevel customer query is created, the query containing parameters relating to a preferred automobile in the kiosk processor. .... a customer-initiated request from the input/display device and storing the customer query and selected inventory in the storage device " ), comprising:*

a car information storage unit stored in a host device and including mappings of car information containing at least a name, a type, a year and a model of a car to car inspection information obtained as a result of inspecting the car concerned (see at least col.5, line 20-col.6, line 36, " *The diagram in FIG. 1 illustrates the components of a preferred embodiment of the present invention. The system is comprised of a terminal 10, terminal processor 10a, a data server 11, a communications device 16, a **storage device 12**, ..... The storage device 12 contains a customer database 19, an inventory database 13, vehicle image files 14, video and sound files 14, and payment module 15. .... **The inventory data 12 includes information about each vehicle as shown in Table 1 below.** ..... The newly-acquired automobiles must be cleaned and given a mechanical examination prior to being formally added to the dealership inventory in the system. Prior to that time, it is not desirable to make a vehicle available for customer queries generated by the present invention. The practice of the present invention includes providing an interface between the check-in system 18 and the storage device 12 so that periodically data relating to newly-acquired vehicles may be uploaded into the storage device 12. This data concerning the newly-acquired vehicles will not be available for customer query at terminal 10 until dealership management has priced the vehicle and declared it ready for sale*

"Note: The inventory data 12 stored in the storage device 12, [ the storage device 12 is part of the kiosk, which corresponds to a host device as claimed. The kiosk includes the terminal 10, the terminal processor 10a, storage device 12 and more] includes mappings of car information containing at least a name, type and a model of the car. Further, the storage device 12 also

includes data if the cars are already examined or not, which corresponds to car inspection information obtained as a result of the car examination. The system of Fig.1 )

a car information input device connected within the host device, the car information input device inputting the car information and causing the car information to be stored in said car information storage unit (see at least col.6, lines 9-23 which discloses including a computerized check-in system 18 for inputting information concerning the cars and also see col.6, lines 37-45 which discloses including keyboards or touch screens as input devices);

a search unit included within the host device and outputting an input screen to input conditions when searching the car information stored in said car information storage unit, and searching based on conditions inputted via the input screen (see at least col.10, lines 50-61, which discloses that the terminal processor 10 searches the car information based on query, that is conditions inputted by the customers via a touch screen. Use of touch screen as an input device is already analyzed above); and

a car information output unit included within the host device outputting display information, including a purchase indication interface transmitting car purchase information containing the searched car information and the car inspection information corresponding to the car information (see at least col.3, lines 36-57, " .....***The present invention also comprehends a method for facilitating an automobile purchase transaction between a customer and an automobile dealership. .... The method further includes providing a customer transaction terminal including a display/input terminal and a terminal processor and providing a storage device containing customer data, vehicle data, vehicle images, instructional audio, video, and a payment module. A multilevel customer query is created, the query containing parameters relating to a preferred automobile in the kiosk processor. .... a customer-initiated request from the input/display device and storing the customer query and selected inventory in the storage device.....***". Note: It is already analyzed above

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the searched car information corresponds to the inspected [examined] car information, see col.6, lines 24-36) .

Regarding claim 2, Green as applied to claim 1 discloses a car sale information providing system according to claim 1, further comprising an inspection indication output unit included within the host device for outputting inspection indicative information for prompting an inspection of an uninspected car corresponding to the input of said car information input device, wherein said car information input device causes the car information of the uninspetced car to be stored in said car information storage unit in a state where the same car is not searchable by said searc unit, and said car information storage unit changes the car information to a searchable state in accordance with an input of the car inspection information created from the inspection based on the inspection indicative information (see at least (see at least col.6, lines 24-36 " *The newly-acquired automobiles must be cleaned and given a mechanical examination prior to being formally added to the dealership inventory in the system. Prior to that time, it is not desirable to make a vehicle available for customer queries generated by the present invention. The practice of the present invention includes providing an interface between the check-in system 18 and the storage device 12 so that periodically data relating to newly-acquired vehicles may be uploaded into the storage device 12. This data concerning the newly-acquired vehicles will not be available for customer query at terminal 10 until dealership management has priced the vehicle and declared it ready for sale ...*". Note:

Mechanical examination, as analyzed above corresponds to inspection of the car as claimed in the instant application. The check-in system 18 corresponds to the claimed inspection indication output unit in the host device and is capable of outputting the inspective indicative information of the car in response to the query input by an user and if the car is not inspected itv will not display car information, which will be indicative of the fact that the car has not been mechanically examined, that is inspected.).

Regarding claims 3-5, their limitations are closely parallel to the limitations of claims 1-2 and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4.1. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green and further in view of Merrick et al. (US Patent 6,433,784); hereinafter referred to as Merrick.

Regarding claims 6-9 all the limitations are already covered in claims 1-5 as analyzed above and anticipated by Green except for storing and exhibiting automobile information in animated image data or sound data. However, Merrick in the same field of endeavor teaches storing and exhibiting automobile information in animated image data or sound data (see at least, col.2, lines 18-31, “ *in the case of a web site for the sale of automobiles, a user might click on the graphic of the particular model that interests him or her resulting in the display of a web page*



*completely dedicated to that model. That page may also include the dynamic animation (often including dialog) representing the company's mascot welcoming the user to the page concerning the particular model. Additionally, the advantages of the real time interaction may be effected such that the character, for example, describes and points to various features of the car based upon user input (e.g. the user points to a portion of the automobile graphic which is of interest).*

“). In view of Merrick, it would have been obvious for one of an ordinary skill in the art at the time of the applicant's invention to have modified Gree to incorporate the feature of storing and exhibiting automobile information in animated image data or sound data because display of animated data for a product stimulates the feelings of the viewers resulting in more active and effective participation of the viewers in the displayed exhibit.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) JP 11-353388 and JP 10-049592, received with IDS on 12/10/2002 renders obvious the claims 1, 3, 5 and 6, when interpreted broadly, because JP 11-353388 discloses containing storing means 12 in a host device for storing data related to vehicles, an input device for inputting data while storing the data, a display unit in the form of an output unit for car information, a search unit for extracting the items of a specific vehicle and the output information and JP 10-049592 discloses retrieving car inspection information along with other information such as price, type, year and model of the car.

(ii) US Patent 6,587,838 to Esposito et al. discloses a method and system for conducting real time electronic commerce, such as purchasing and selling vehicles (see at least col.5, line 22-col.7, line 36).

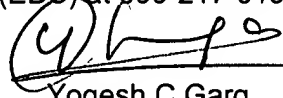
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(iii) US Patent 5,844,987 to Matthews et al. discloses a communication system and method for using vehicle identifications wherein a database in a computer system. Stores vehicle information which can be communicated to an external terminal, and further allowing to input information, search information and retrieve information related to a vehicle (see at least col.3, line 5-col.9, line 32).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
April 17, 2005